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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/480,645

01/10/2000

Timothy A. Lavery

IMGXP01

4567

22434

7590

03/29/2004

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EXAMINER

WALLERSON, MARK E

ART UNIT

PAPER NUMBER

2626

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/480,645

Applicant(s)

LAVERTY ET AL.

Examiner

Mark E. Wallerson

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 16-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 16-30 and 32-44 is/are rejected.
- 7) ☐ Claim(s) 31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**Part III DETAILED ACTION**

***Notice to Applicant(s)***

1. This action is responsive to the following communications: amendment filed on 9/15/03.
2. This application has been reconsidered. Claims 16-44 are pending.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 16-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 16, the phrase a "normalized" EPS file in line 9 is unclear.

With respect to claim 16, the phrase "a consistent format" in line 9 is unclear.

With respect to claim 16, "a variety of software applications" in line 11 is indefinite.

5. Claim 16 recites the limitation "the information " in line 1. There is insufficient antecedent basis for this limitation in the claim.
6. Claim 25 recites the limitation "the color information" in line 1. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 16-30, and 32-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Vogt et al (Vogt) (U.S. 6,611,349).

With respect to claims 16, 17, 23, 25, 32, 33, 34, 36, 37, 38, Vogt discloses a source Encapsulated PostScript file (which reads on a Postscript file) (column 11, lines 32-44), wherein the Postscript file contains unstructured information required to create a printed document (column 11, lines 32-44); a first conversion module for automatically converting the Postscript file to a PDF file using a first set of parameters (column 11, lines 32-44); a second conversion module for converting the PDF file to normal Postscript file (approved for printing) using a second set of parameters, wherein different software applications (software infrastructure) can use the information to access the Postscript file (column 13, lines 26-40).

With regard to claims 18, 26, and 39, Vogt discloses a Prepress operation (column 10, lines 27-43).

With respect to claims 20, 35, and 41, Vogt discloses the predefined parameters include a consistent format for color information (column 10, lines 16-43).

With regard to claims 21, 28, and 42, Vogt discloses a Postscript interpreter (which reads on server (110)) for converting the Postscript file).

With regard to claims 22, 29, and 43, Vogt discloses a PDF library for converting the PDF file (column 13, lines 34-40).

With respect to claims 24, 30, and 44, Vogt discloses the Postscript, PDF and normalized Postscript files are stored on a file server (110).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 19, 27, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vogt in view of Stumbo et al (Stumbo) (U.S. 6,084,688).

With respect to claims 19, 27, and 40, Vogt differs from claims 19, 27 and 40 in that he does not clearly disclose a Level 1 Postscript file. Stumbo discloses a printing system wherein a PDF file is converted to a Level 1 Postscript file (column 7, lines 36-52 and column 9, lines 22-55). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Vogt wherein the PDF file is converted to a Level 1 Postscript file. It would have been obvious to one of ordinary skill in the art at the time of the invention to

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have modified Vogt by the teaching of Stumbo in order to improve the output of the jobs to the printing apparatus.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, DC 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two  
2121 Crystal Drive  
Arlington, VA.  
Sixth Floor (Receptionist)

MARK WALLERSON  
PRIMARY EXAMINER

MARK WALLERSON